

Remarks

In the October 28 Action, the Examiner withdrew the finality of the previous Action.

The Examiner maintained the rejection of claim 7 under § 112, first paragraph.

The Examiner also maintained the rejection of claims 1-9 under § 112, second paragraph.

The Examiner additionally maintained the rejection of claims 1-3 and 5-8 under § 102(a) and § 102(f), and entered a new ground of rejection of these claims under § 102(b).

The Examiner maintained the rejection of claim 9 under § 103(a).

In view of the clarifications presented herein, it is urged that all pending claims, i.e. claims 1-9, are in condition for allowance.

A. Rejection of Claim 7 Under § 112, First Paragraph, Must Be Withdrawn

The Examiner asserted in this regard:

Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. See the reasons of record in the Office Action mailed on 12 July 2004.

Page 2 of the October 28 Action.

The Examiner further argued in this regard.

In view of applicants arguments, applicant traverses the section 112, first paragraph rejection of the Office Action mailed on 12 July 2004. Applicant cites a passage at pages 7 and 8 of the Specification in order to demonstrate antecedent support. The cited passage specifies an amount of zinc that is not specified in Claim 7. It is unclear what is the basis for support for a broader claim that does not specify the amount of zinc. None of Applicants' citations to "further support" at the conclusion of Applicants' arguments discloses the entirety of the invention as now claimed in Claim 7. Only certain of the elements of Claim 7 appear to be taught in each citation. For example, original Claim 7 does not leave the amount of zinc unspecified.

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Apparently, the Examiner concedes that all aspects in claim 7 are supported by the specification except for the amount of zinc called for in claim 7.

Claim 7 does not expressly recite the amount of zinc, but rather indirectly recites it by reciting the amounts of aluminum and paste liquid.

In the above-quoted passage, the Examiner stated that "the cited passage [at pages 7 and 8 of the specification] specifies an amount of zinc that is not specified in Claim 7" (bracketed text added). It is unclear why the Examiner is concerned with whether a statement in the specification appears in a claim. That is not the standard for determining whether a claim satisfies the requirements of § 112, first paragraph.

The proper standard for evaluating whether claim 7 meets the requirements of § 112, first paragraph, and thus finds sufficient written description support in the specification is as follows:

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language.

In re Kaslow, 707 F.2d 1366, 217 USPQ 1089 (Fed. Cir. 1983), citing *In re Edwards*, 558 [568] F.2d 1349, 196 USPQ 465 (CCPA 1978); *In re Herschler*, 591 F.2d 693, 200 USPQ 711 (CCPA 1979). This standard is still the one to be used today. "The written description requirement does not require the applicant 'to describe exactly the subject matter claimed, [instead] the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed.'" *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 66 USPQ2d 1429 (Fed. Cir. 2003), citing *Union Oil Co. of Cal. v. Atlantic Richfield Co.*, 208 F.3d 989, 997 54 USPQ2d 1227, 1232 (Fed. Cir. 2000).

The present application, as originally filed, clearly demonstrates that the inventors had possession at that time, of the subject matter of claim 7. Claim 7 in its present form, parallels claim 7 as originally filed.

The Examiner is respectfully reminded that the standard for assessing whether claim 7 meets the written description requirement under § 112, first paragraph does not involve, nor require, literal correspondence between the words in the claim and words in the specification.

In order to comply with the written description requirement, the specification need not describe the claimed subject matter in exactly the same terms as used in the claims; it must simply

indicate to persons skilled in the art that as of the [filing] date the applicant had invented what is now claimed'.

Eiselstein v. Frank, 52 F.3d 1035, 1038, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995) citing *Vas-Cath*, 935 F.2d at 1562, 19 USPQ2d at 1115, and *In re Wertheim*, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976).

As for the Examiner's apparent concern over the manner in which claim 7 recites the amount of zinc, it is entirely permissible to not expressly recite a specific amount or range of zinc. Furthermore, it is entirely permissible to indirectly recite an amount of zinc by reciting amounts of aluminum and paste liquid. For at least these reasons, the present rejection of claim 7, must as a matter of law, be withdrawn.

B. Rejection of Claims 1-9 Under § 112, Second Paragraph Must Be Withdrawn

In this regard, the Examiner contended:

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding Claims 1, 2, 4, and 6-8, it is unclear what is being admitted as the composition of the prior art. See the reasons of record in the Office Action mailed on 12 July 2004,

Regarding Claims 1, 2, 4, and 6-8, it is unclear what is required by the references to "curing" and "cured". It is unclear whether the limitation "adapted for application to, and curing on" constitutes a compositional requirement, or not. Can a composition be adapted for application and curing without further requiring some compositional ingredient that cures? See the reasons of record in the Office Action mailed on 12 July 2004.

Pages 2-3 of the Action.

And, in response to Applicants' previous explanations on this matter, the Examiner asserted:

In view of Applicants' arguments, applicant traverses the section 112, second paragraph rejection of the Office Action mailed on 12 July 2004. Applicant argues that there is no admission of prior art. However, the claim format appears to be that of Jepson format, in which, by convention, the preamble is admitted prior art. Applicant argues that the claims do not require a curing agent in the composition. However, applicant appears to say that the coating composition is to undergo curing. It is unclear what is the material that applicant considers applicant has claimed and that would be cured.

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The Examiner rejected claims 1-9 under § 112, second paragraph for allegedly being indefinite. However, the Examiner did not present any explanation as to why, in the Examiner's view, those claims are indefinite for "failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." The Court of Appeals for the Federal Circuit has repeatedly held the standard for evaluating whether a claim satisfies the requirement under § 112, second paragraph, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Morton International, Inc. v. Cardinal Chemical Co.*, 5 F.3d 1464, 28 USPQ2d 1190 (Fed. Cir. 1993). It is respectfully urged that a person skilled in the field of coatings would readily understand what is claimed in claims 1-9, and particularly when read in view of the present application.

Concerning the Examiner's argument that the claims themselves admit certain prior art, Applicant again states for the record that none of the pending claims contain any admission as to prior art. Each claim is believed to recite patentable subject matter.

As for the Examiner's characterization of the preamble in the claims being admitted prior art, Applicant submits the following. The claims at issue, i.e. claims 1, 2, 4 and 6-8, utilize a preamble that merely defines the context or environment for the recited aspects in those claims. No admission as to what may be prior art is being made by any of those claims. As to the Examiner's characterization of the claims as Jepson claims, Applicant submits that it is irrelevant whether those claims are considered to be in Jepson format. The Court of Appeals for the Federal Circuit has explained in this regard, "[The Jepson form of claim] is to be considered a combination claim. The preamble of this form of claim is considered to positively and clearly include all the elements or steps recited therein as a part of the claimed combination." *Rowe v. Dror*, 112 F.3d 473, 42 USPQ2d 1550 (Fed. Cir. 1997). The Examiner is also respectfully referred to the MPEP which states in this regard:

The form of claim required in 37 CFR 1.75(e) is particularly adapted for the description of improvement-type inventions. It is to be considered a combination claim. The preamble of this form of claim is considered to positively and clearly include all the elements or steps recited therein as a part of the claimed combination.

As for the Examiner's concern over whether the claims require a curing agent, please note the following. The claimed subject matter does not require the use of a curing agent. The term "cured" or "curing" refers to a chemical or physical process that improves the properties of the material undergoing curing. Specifically, in the claimed subject matter, curing refers to reactions, generally irreversible, occurring as a result of heating that improve the properties of the coating. No curing agent is required.

For at least these reasons, the rejection of claims 1-9 under § 112, second paragraph must, as a matter of law, be withdrawn.

C. Rejection of Claims 1-3 and 5-8 Under § 102 (a, b, and f) Must Be Withdrawn

In support of this rejection, the Examiner asserted:

Claims 1 and 5-8 are rejected under 35 U.S.C., 102(a or b or f) as being anticipated by Applicants' Admissions with respect to Eckart STAPA 4ZnAl7. See the reasons of record in the Office Action mailed on 12 July 2004. Claims 2 and 3 are rejected under 35 U.S.C. 102(a or b or f) as being anticipated by Applicants' Admissions with respect to Eckart STAPA 4ZnSn3G. See the reasons of record in the Office Action mailed on 12 July 2004.

Pages 3-4 of the Action.

In response to Applicant's previous explanations as to why this ground of rejection is improper, the Examiner argued:

Applicant has submitted a Declaration on 13 October 2004 by Inventors Dorsett and Guhde. The declaration provides supporting documentation for Applicants' contention that the Eckart pastes that are the subject of the section 102 (a or f) rejections in the Office Action mailed on 12 July 2004 were derived from Applicants' prior work. It appears to be correct that inventors of the instant application were involved in preparing the pastes at issue. In paragraph 5 of the declaration, declarants state that the Eckart pastes at issue are mentioned in the provisional application. While the Zn/Al paste is observed to be mentioned, it is unclear where the Zn/Sn paste is mentioned. Paragraph 28 of the Declaration states that the Eckart pastes at issue were incorporated into the STAPA line of pastes upon Dacral "requesting and specifying the pastes from Eckart" and upon Eckart providing the pastes. It is understood that at least at the time that the pastes were incorporated into the "line of pastes" the pastes would be considered on sale in the United States. Eckart is described as providing pastes in paragraph 13. It is unclear what is the date of the referenced letter, but it may be 1996. Paragraph 16 appears to refer to testing of the paste materials on or prior to 7 February 2000, Paragraph 18 refers to a letter that is apparently not provided. Paragraph 19 is a letter from Eckart that

appears to suggest that development of the pastes was considered a partnership arrangement among MCII, Dacral, and NDS, and Doral (affiliated with Eckart). Paragraph 20 describes a notebook in which the STAPA designation for the Zn/Al paste is used over the period 19 December 2000 through 19 January 2001. Paragraphs 24-27 describe purchase orders for STAPA pastes at issue in March 2001 and later. Which of these dates, if any, represents the time of first sale in the United States is not clarified in the provided information. However, absent more specific information, the earliest dates, of either 1996 or earlier than 7 February 2000, in view of the language of paragraph 28, may be presumed to be the first on sale in the United States dates. Both of these dates precede the provisional filing date by more than one year. Applicant may choose to submit additional information in order to demonstrate that the first sale of the Zn/Al paste occurred within a year of the occurred within a year of the provisional filing date and that the first sale of the Zn/Sn paste occurred within a year of the application filing date.

Pages 5-7 of the Action.

The Examiner makes several unsupported and incorrect assumptions by basing the present anticipation rejection upon the STAPA pastes and whether those pastes were on sale or not on sale. One erroneous assumption throughout the Examiner's analysis is that the STAPA pastes are identical to the coating compositions recited in the claims at issue. No. Those pastes are merely a component of the claimed coatings and were noted as examples of commercially available sources for the recited zinc alloy. This is explained below. Secondly, assuming for purposes of argument that the STAPA pastes identically correspond to the claimed coating compositions (which, Applicant vehemently contests), those pastes are not prior art to the present claims since they were derived from the present inventors' own prior work. This matter is also explained below.

It is also unclear why the Examiner mischaracterizes many of the statements presented in the Declaration filed on October 11, 2004. For example, the Examiner states with regard to paragraph 18 of that Declaration that a referenced letter was "apparently not provided." In point of fact, that letter was provided as exhibit D to the Declaration. Paragraph 18 of the Declaration specifically refers to the letter as attached in Exhibit D.¹ The Examiner also mischaracterized the development of pastes as a "partnership" among MCII, Dacral, NDS, and Doral, due to a letter referenced as Exhibit E in paragraph 19 of the Declaration. Although the word "partnership" is found in the Exhibit E letter,

¹ If the Examiner is still missing that letter or any other referenced exhibit, the Examiner is requested to contact the undersigned.

that term refers to a financial relationship between the parties and does not refer to any aspect of the technical development or inventive aspects of the pastes. Again, it is unclear as to why the Examiner makes such a mischaracterization. The previously cited Declaration is quite specific in this regard. It is also troubling as to the manner in which the Examiner assumes various dates for letters or occurrences for which dates are unknown. Unless the Examiner has evidence to support such assumptions, it is respectfully submitted that speculations not be made. Turning attention to the substantive aspects of the present rejection, the Examiner is requested to consider the following.

1. The Cited Pastes Do Not Anticipate the Claimed Coating Compositions

The present rejection must be withdrawn because the cited pastes do not anticipate the claims at issue. The Examiner is respectfully reminded that "[a]nticipation under Section 102 can be found only if a reference shows exactly what is claimed." *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). Claims 1-3 and 5-8 are all directed to a coating composition adapted for application to, and curing on, a substrate, in which the coating composition contains particulate metal in a liquid medium. The claimed coating compositions provide corrosion resistance as a cured coating on the substrate. The zinc/aluminum pastes cited by the Examiner do not anticipate claims 1-3 and 5-8. The pastes are not adapted for application to, and curing on, a substrate. The pastes do not provide corrosion resistance as a cured coating on the substrate. The pastes are not coatings. The pastes do not provide corrosion resistance as a coating. The paste is a component in the claimed coatings. Simply put, the noted STAPA zinc/aluminum pastes fail to anticipate the corrosion resistant coating compositions recited in the pending claims.

For the same reasons as previously expressed, the cited zinc/tin pastes do not anticipate the claimed coating compositions called for in claims 2 and 3. Those claims also recite a coating composition that is adapted for application to, and curing on, a substrate. And, those claims recite the composition as containing particulate metal in a liquid medium which provides corrosion resistance as a cured coating on the substrate. Simply put, the cited STAPA zinc/tin pastes do not anticipate the subject matter of claims 2 and 3.

The Examiner is respectfully reminded of the Federal Circuit's instructions as to the standard for anticipation rejections. "Anticipation under 35 USC § 102 requires that a single prior art reference disclose each and every limitation of the claimed invention." *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 66 USPQ2d 1429 (Fed. Cir. 2003). Anticipation requires "[e]very element of the claimed invention must be literally present, arranged as in the claim." *Lewmar Marine, Inc. v. Barient, Inc.*, 827 F.2d 744, 3 USPQ2d 1766 (Fed. Cir. 1987), *cert denied*, 484 US 1007 (1988). The cited pastes do not anticipate the claimed coating compositions. The cited pastes do not identically respond to the corrosion resistant coating compositions recited in claims 1-3 and 5-8.

In the latest Office Action the Examiner argued in this regard:

In view of applicant's arguments and applicant's declaration, applicant traverses the section 102 (a or f) rejection over applicant's Admissions with respect to the Eckart STAPA Zn/Al paste....Applicant argues that the paste does not anticipate the claim because the claim is directed to a coating composition, as opposed to a paste, which is a component of a coating composition. The pastes comprise liquid and flake of the claimed alloy composition, and so rejection is appropriate. The relied upon claim language for distinguishing the paste from the composition is indefinite and hence the argument is not persuasive.

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The Examiner reiterated the same argument for the zinc/tin paste as was made for the zinc/aluminum paste:

In view of Applicants' arguments and applicant's declaration, applicant traverses the section 102 (a or f) rejection over applicant's Admissions with respect to the Eckart STAPA Zn/Sn paste....Applicant argues that the paste does not anticipate the claim because the claim is directed to a coating composition, as opposed to a paste, which is a component of a coating composition. The pastes comprise liquid and flake of the claimed alloy composition, and so rejection is appropriate. The relied upon claim language for distinguishing the paste from the composition is indefinite and hence the argument is not persuasive.

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In these arguments, the Examiner equates the STAPA pastes with the claimed coating compositions and jumps to a conclusion of anticipation by arguing that various recitations in the claim are indefinite, and thus in the Examiner's view can be ignored. This is not a proper analysis. First, the Examiner fails to specify exactly which passages or recitations in the claims are believed to be indefinite. Without presenting any reasons why "[t]he relied upon claim language for

distinguishing the paste from the composition is indefinite and hence the argument is not persuasive," it is the Examiner's unsupported contention that fails.

Moreover, if certain recitations in the claims were indefinite as the Examiner argues, then the Examiner should have identified that specific language in the rejection under § 112, second paragraph. Simply put, the Examiner's argument that various claim recitations can be ignored, is entirely unsupported and thus fails.

2. The Cited Pastes Were Conceived and Developed by the Inventors Themselves and Thus, Are Not Prior Art

As evidenced by the previously submitted Declaration, the Eckart STAPA pastes noted in the present application are not prior art to the pending claims. The Eckart alloy pastes cannot be used as a prior art reference because the Eckart alloy pastes were derived from Applicant's own prior work.

Absent a statutory basis, an inventor's own prior original work will not anticipate his later inventions. In *In re Katz*, 215 USPQ 14 (CCPA 1982), the court stated:

Thus, one's own work is not prior art under § 102(a) even though it has been disclosed to the public in a manner or form which otherwise would fall under § 102(a).

See also Illinois Tool Works, Inc. v. Solo cup Co., 461 F.2d 265, 172 USPQ 385 (7th Cir. 1972); *In re Faucius*, 408 F.2d 1396, 161 USPQ 294 (CCPA 1969) ("But certainly one's own invention, whatever the form of disclosure to the public, may not be prior art against oneself, absent a statutory bar.").

As explained and evidenced in the previously submitted Declaration by two of the named inventors of the present application, the STAPA zinc/aluminum paste available from Eckart was conceived and developed by the present inventors themselves. That is, the Eckart STAPA 4ZnAl7 zinc/aluminum alloy paste was supplied to the assignee of the present application after development by the present inventors, and based upon information and specifications provided to Eckart by the inventors and/or their assignee. The noted STAPA paste resulted from the present inventors' own work.

As explained and evidenced in the previously submitted Declaration by two of the named inventors of the present application, the STAPA zinc/tin paste

available from Eckart was also conceived and developed by the inventors themselves. That is, the Eckart STAPA 4ZnSn30 zinc/tin alloy paste was supplied to the assignee of the present application after development by the present inventors, and based upon information and specifications provided to Eckart by the inventors and/or their assignee. The noted STAPA paste resulted from the present inventors' own work.

In this regard, the Examiner also argued that:

Furthermore, while applicant may have contributed to developing the paste, it is unclear whether the inventive entity with respect to the paste is the same as with respect to the composition containing the paste. In view of the characterization of the working relationship as a "partnership" for developing the paste and in view of the explanation that the claimed invention is not a paste but a composition containing a paste, it is not clear that the same inventive entity was involved in making the paste as was involved in the claimed invention.

* * *

Furthermore, while applicant may have contributed to developing the paste, it is unclear whether the inventive entity with respect to the paste is the same as with respect to the composition containing the paste. In view of the characterization of the working relationship as a "partnership" for developing the paste and in view of the explanation that the claimed invention is not a paste but a composition containing a paste, it is not clear that the same inventive entity was involved in making the paste as was involved in the claimed invention.

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Again, the Examiner blurs the distinction between the pastes, which are a component of the claimed compositions, and the claimed compositions themselves. The previously submitted Declaration evidenced that the STAPA pastes were conceived and developed by the inventors themselves. Specifically, the zinc/aluminum alloy paste containing 7% aluminum and the zinc/tin alloy paste containing 30% tin resulted from the present inventors' own work.

The Examiner inquired into whether the inventive entity of the paste is the same as the claimed compositions. Applicant submits, again, that the paste at issue originated from the work of the same inventive entity as for the present application.²

² Etienne Maze, Gilbert Lelong, Terry Dorsett, Donald Guhde, and Toshio Hishikawa.

For at least these reasons, the present rejection must as a matter of law be withdrawn.

In the most recent Office Action, the Examiner also entered a new ground of rejection under § 102(b). Specifically, the Examiner asserted:

Rejection under section 102 (b) appears to be appropriate in view of the explanation of paragraph 28. It appears that the described activities may have involved on sale bar activities prior to one year before the provisional application filing date of 14 February 2001.

* * *

Rejection under section 102 (b) appears to be appropriate in view of the explanation of paragraph 28. It appears that the described activities may have involved on sale bar activities prior to one year before the application filing date of 15 January 2002. VI.

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Specifically, the Examiner rejected claims 1 and 5-8 under 35 USC § 102(b) for reciting subject matter that was allegedly on-sale more than one year prior to the provisional filing date of February 14, 2001. The Examiner also rejected claims 2 and 3 under 35 USC § 102(b) for reciting subject matter that was allegedly on-sale more than one year prior to the application filing date of January 15, 2002. Applicant traverses the rejections.

In support of these rejections, the Examiner stated that he presumed the first on-sale date in the US to be either 1996 or earlier than February 7, 2000. This presumption arose from his interpretation of the language of Paragraph 28 of the Declaration filed October 11, 2004. However, Applicant submits that both of the STAPA pastes (4ZnAl7 and 4ZnSn30) are not the same as that which the claims at issue recite and therefore do not invoke the on-sale bar for either date. In *Pfaff v. Wells*, 525 U.S. 55 (1998), the U.S. Supreme Court stated that the on-sale bar applies to an invention when two conditions are satisfied before the critical date: (1) the invention is the subject of a commercial offer for sale and (2) the invention is ready for patenting. The invention can shown to be "ready for patenting" either by proof of reduction to practice before the critical date or by proof that the inventors had prepared descriptions of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention. The STAPA pastes are not the same subject matter as the coating compositions claimed herein; they are components of the claimed compositions. Therefore, the

coating compositions were not the subject of a commercial offer for sale either in 1996 or prior to February 7, 2000.

With regard to the latter date of "prior to February 7, 2000," the coating compositions also were not ready for patenting on that date. As stated in Paragraph 20 of the Declaration, Applicant was still testing the compositions as late as January 19, 2001 in order to ascertain their patentability. The testing was being performed to ascertain whether the compositions would fulfill their intended purpose and would fall under the experimental use exception to the on-sale bar of § 102(b). See *LaBounty v. U.S. I.T.C.*, 958 F.2d 1066, 1071, 22 USPQ.2d 1025 (Fed. Cir. 1992).

The Examiner also argued that he could not find support for the Zn/Sn paste in the provisional application. Consequently, he applied the critical date as one year prior to the application filing date of January 15, 2002. Support for the Zn/Sn paste claimed in claims 2 and 3 can be found in the provisional application at page 5, lines 5-7. There, it is stated that tin may be present in a Zn/Sn alloy in an amount from about 10 to about 70 weight percent. Claim 3 has been amended to recite that range of tin in the alloy flake. Applicant therefore submits the critical date for the zinc/tin alloy is also one year prior to the filing date of the provisional application, i.e. February 14, 2001, and not one year prior to the filing date of the present application, i.e. January 15, 2002.

For at least these reasons, the rejections under § 102 (a, b, or f) must as a matter of law, be withdrawn. Namely, the cited STAPA pastes do not anticipate the claimed coating compositions. Notwithstanding that fact, the cited STAPA pastes were conceived and developed by the inventors themselves and thus, are not prior art to the pending claims.

D. Rejection of Claim 9 Under § 103(a) Must Be Withdrawn

The Examiner maintained the rejection of claim 9 as follows:

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaliardos USP 4,356,036 in view of Applicants' Admissions for the reasons of record in the Office Action mailed on 12 July 2004.

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In response to Applicants' previous explanations on this matter, the Examiner argued:

In view of applicant's arguments and applicant's declaration, applicant traverses the section 103, rejection over Kaliardos in view of Application's Admissions of the Office Action mailed on 12 July 2004. Applicant's reasons for traversal are addressed above in discussing the section 102 rejections and whether the Eckart STAPA Zn/Al paste is prior art.

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Claim 9 recites a coating composition adapted for application to, and curing on, a substrate, in which the composition contains zinc alloy in flake form and in which at least about 90 percent of the flake particles have a longest dimension of less than about 15 microns and at least about 50 percent of the flake particles have a longest dimension of less than about 13 microns. Claim 9 continues and recites the zinc alloy comprises greater than about 80 weight percent zinc in the flake and a balance of less than about 20 weight percent of aluminum in the flake. Claim 9 also recites that the composition further contains non-alloyed particulate metal.

The '036 patent to Kaliardos, although directed to anti-corrosion coatings which can contain a mixture of aluminum or zinc paste, fails to teach or describe in any manner a paste containing zinc alloys. Furthermore, the '036 patent entirely fails to teach or suggest the specific recitations in claim 9 concerning the longest dimension of the zinc alloy flakes, and the population distribution of sizes of those flakes. Moreover, the '036 patent completely fails to teach or even suggest anything regarding the language in claim 9 that the zinc alloy comprises greater than about 80 percent zinc in the flake and a balance of less than about 20 percent aluminum in the flake.³

The Examiner is respectfully reminded of the proper standard for rejecting a claim under § 103:

The PTO has the burden under section 103 to establish a prima facie case of obviousness....It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.

³ The Examiner attempts to combine the '036 patent with "Applicants' Admissions." As previously explained, Applicant has not made any admissions. If the Examiner continues to assert this view, it is respectfully requested that the Examiner specifically list and state such admission.

In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

The Examiner has not met this burden. The Examiner has not cited any teachings as to the previously noted recitations in claim 9 concerning the zinc alloy, its formulation, or its particle size population distribution. Furthermore, the Examiner has not cited any teaching to motivate one to utilize a zinc alloy in flake form in an anti-corrosion coating.

In fact, if one followed the teachings of the '036 patent, one would actually be led away from the subject matter of claim 9 since the '036 patent actually teaches away from the subject matter of claim 9. Upon closer inspection, it is evident that the '036 patent teaches the use of a mixture of particulate metals instead of an alloy as recited in claim 9. For at least these reasons, the rejection of claim 9 under § 103, must as a matter of law, be withdrawn.

E. Supplemental Information Disclosure Statement

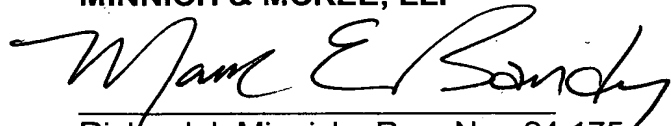
Applicant also encloses a Supplemental Information Disclosure Statement citing EP 1116756.

F. Conclusion

In view of the foregoing, it is respectfully submitted that all pending claims 1-9 are patentable over the cited art.

Respectfully submitted,

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